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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,740	11/06/2001	Robert C. Chang	SANDP011	9137

10027 7590 12/19/2005

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EXAMINER

WOOD, WILLIAM H

ART UNIT	PAPER NUMBER
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2193

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/005,740	Applicant(s) CHANG ET AL.	
	Examiner William H. Wood	Art Unit 2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-10, 13, 15-18 and 26-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-10 is/are allowed.
- 6) ☒ Claim(s) 3-7, 13, 15-18 and 26-30 is/are rejected.
- 7) ☒ Claim(s) 4-7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 3-10, 13, 15-18 and 26-30 are pending and have been examined.

Claim Objections

1. Claims 4-7 are objected to because of the following informalities: claims dependent upon now cancelled claim 1 or derivatives thereof. Appropriate correction is required. Rejections below treated as if dependency is to claim 3.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 3-7, 15-17 and 26-27 are rejected under 35 U.S.C. 102(a) as being anticipated by **Graham** et al. (WO 01/78020 A1). For the sake of brevity, the rejections will not be repeated from the previous action and are considered the same. Were appropriate, additional elements will be addressed.

Claims 3 and 13

Graham disclosed firmware, for controlling the execution of instructions by control functions in the memory storage device (*page 38, lines 7-10; page 37, lines 18-22; page 39, line 28 to page 40, line 2*).

Graham disclosed the method substantially the same as claim 1 and 2, noted in a previous rejection. **Graham** further disclosed extracting the embedded new firmware from the first command, wherein the reader extracts the embedded new firmware (*page 39, lines 1-2*). *Limitation being rolled into claim 13 as well from claim 14.

Claim 26

Graham disclosed the method of claim 1 further including:

embedding the new firmware into a first command, wherein sending the new firmware from the host to the reader includes sending the first command from the host to the reader (*page 38, line 27 to page 39, line 2*).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Graham** et al. (WO 01/78020 A1) in view of **Pua** et al. (US Patent Publication 2002/0194403). For the sake of brevity, the rejections will not be repeated from the previous action and are considered the same.

6. Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Graham** et al. (WO 01/78020 A1) in view of **Watanabe** (USPN 6,148,366). For the sake of brevity, the rejections will not be repeated from the previous action and are considered the same. Were appropriate, additional elements will be addressed.

Claim 30

Graham and **Watanabe** disclosed the method of claim 28 wherein the at least first bit is arranged to substantially cause the firmware associated with the reader to set an internal flag to indicate that the in-system-programming updated of the firmware is supported (**Watanabe**: figures 3-4).

Allowable Subject Matter

7. Claims 8-10 are allowed.

The following is an examiner's statement of reasons for allowance: the prior art of record fails to teach or suggest the claimed invention. Specifically, the prior art of record fails to teach or suggest communicably detaching and reattaching the reader with resetting the memory storage device, as recited in independent claim 8.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

8. Applicant's arguments filed 10 February 2005 have been fully considered but they are not persuasive. Applicant argues **Graham** fails to disclose extracting the embedded firmware from the first command as now found in claims 3 and 13. Upon review of the cited prior art, this line of reasoning is not persuasive. **Graham** clearly indicates processing (extraction of information) from commands sent to the reader (page 39, lines 1-2, "or [the terminal] may be as complex as a merchant terminal that includes a processor, application software, and the ability to communicate over a network"). The three elements, a processor, software and communication over a network, clearly indicate extraction of embedded information. Information is coming from over the network to the reader (the terminal), which then must be converted from network format to memory device (card) format. Thus, the rejections are maintained.

Conclusion

9. Rejection is made Non-Final due to the oversight of not properly addressing the limitations of claim 14 (now rolled into claim 13) in the previous Office Action.

Art Unit: 2193

Correspondence Information


Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Wood whose telephone number is (571)-272-3736. The examiner can normally be reached 9:00am - 5:30pm Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571)-272-3719. The fax phone numbers for the organization where this application or proceeding is assigned are (571)273-8300 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.



William H. Wood
December 1, 2005



KAKALI CHAKI
ASSISTANT PATENT EXAMINER
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